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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,968	08/10/2006	Ryuichi Okamoto	2006_1217A	4029
52349	7590	03/02/2010	EXAMINER	
WENDEROTH, LIND & PONACK L.L.P.			HUERTA, ALEXANDER Q	
1030 15th Street, N.W.			ART UNIT	PAPER NUMBER
Suite 400 East				
Washington, DC 20005-1503			2427	
			NOTIFICATION DATE	DELIVERY MODE
			03/02/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/588,968	OKAMOTO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alexander Q. Huerta	2427	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 October 2009.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3 and 7-13 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,3 and 7-13 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 08 October 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3, and 7-13 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 13** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim **13** sets forth a “**computer readable recording medium**.” However, the specification as originally filed does not explicitly define **the computer readable recording medium by stating that it ' . . . includes, but is not limited to' a number of various mediums (Para. 134)**. The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a **computer readable recording media** (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is absent an explicit definition or is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim

must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1, 3, 7-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe (US Pub. **2005/0124407**) in view of Bryant et al. (US Pat. **7,318,774**), herein referenced as Rowe and Bryant, respectively.

Regarding **claim 1**, Rowe discloses “a content reproduction terminal (gaming machine 200) for reproducing content, the content reproduction terminal comprising: a terminal body (gaming machine case); and a secure device (smart card 100) removable from said terminal body, said secure device includes: ...a first storage unit operable to previously store a first application program for reproducing the content ...” (*Abstract*, [0014], [0054], Figs. 1-2, i.e. gaming applications are stored on the smart card which are downloaded to the gaming machine)

“said reproduction unit includes: a second storage unit operable to previously store a second application program for reproducing the content...” ([0014], [0054],

[0093]-[0094], Fig. 3, i.e. game component information can be stored in RAM, hard drive 320, non-volatile memory 335).

Rowe fails to disclose "wherein said secure device includes: a membership information hold unit operable to hold membership information which is distributed to a membership user and indicates a group to which the user belongs, said terminal body includes: an operation mode setting unit operable to set an operation mode on the basis of the membership information held by said membership information hold unit; and reproduction unit operable to reproduce the content differently depending on a setting result given by said operation mode setting unit, wherein said reproduction unit includes:...the second application program being different from the first application program; a selection unit operable to select one of the first application program and the second application program which are stored in said first storage unit and said second storage unit, respectively, in accordance with the setting result; and an execution unit operable to execute the application program selected by the selection unit to reproduce the content, wherein the first application program is operable to cause said execution unit to execute a members-only decorative display."

Bryant discloses "wherein said secure device includes: a membership information hold unit operable to hold membership information which is distributed to a membership user and indicates a group to which the user belongs" (Col. 2 lines 1-18, Col. 4 lines 22-39, i.e. the membership information is stored within the smartcard, Fig. 3)

“said terminal body includes: an operation mode setting unit operable to set an operation mode on the basis of the membership information held by said membership information hold unit (Col. 2 lines 1-29, i.e. when the membership card is inserted into the card reader the console will determine if the user is a member. If the user is a member then the console will operate in the second members-only mode); and a reproduction unit (controller 30) operable to reproduce the content differently depending on a setting result given by said operation mode setting unit” (Col. 4 lines 9-21)

“wherein said reproduction unit includes:...the second application program being different from the first application program; a selection unit operable to select one of the first application program (second mode available only to members) and the second application program (first mode available to all players) which are stored in said first storage unit and said second storage unit, respectively, in accordance with the setting result (Col. 2 lines 1-29, Col. 5 lines 31-50, i.e. a test is performed to determine if the member card has been inserted. If the result is yes, then the game will feature a second mode available only to members); and an execution unit (control processor 31) operable to execute the application program selected by the selection unit to reproduce the content (Col. 4 lines 9-21), wherein the first application program is operable to cause said execution unit to execute a members-only decorative display.” (Col. 1 line 46-Col. 2 line 29, Col. 5 lines 4-13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the smart card gaming machine system of Rowe by specifically providing two application programs in which the first application program

is provided for members-only as taught by Bryant, for the purpose of providing users with an incentive to become members to view enhanced game modes.

Regarding **claim 3**, Rowe fails to disclose that “the first application program is further operable to cause said execution unit to execute a members-only graphical user interface display.”

Bryant discloses that “the first application program is further operable to cause said execution unit to execute a members-only graphical user interface display.” (Col. 1 line 46-Col. 2 line 29, Col. 5 lines 4-13, Figs. 5-6). Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of providing a members-only graphical user interface display as taught by Bryant, to improve the smart card gaming machine system of Rowe for the predictable result of providing users with an incentive to become members to view enhanced game modes.

Regarding **claim 7**, Rowe discloses “an operation mode inquiry unit operable to inquire of said secure device about which operation mode is to be selected” ([0064], [0093]-[0094], i.e. the game machine transmits application requests to the smart card), and

“said secure device further includes an operation mode instruction unit (processor 110) operable to, when the inquiry is received, decide the operation mode on the basis of the membership information and to instruct said terminal body to operate in the decided operation mode, wherein said operation mode setting unit (I/O interface 120) is operable to set the operation mode on the basis of the instruction as to the operation mode decided by the operation mode instruction unit.” ([0014], [0025]-[0026],

[0093]-[0094], Figs. 1, 3, 6, i.e. the processor receives game application selections from the game machine so as to instruct which game to run. In addition, the I/O interface communicates setting instruction to the game machine).

Regarding **claim 8**, Rowe discloses that “said membership information hold unit is operable to hold a plurality of sets of membership information ([0011], [0091], i.e. player tracking information, loyalty points, game play history, etc.), and said operation mode instruction unit is operable to, when the inquiry is received, decide the operation mode including a set of membership information that is to be prioritized out of the plurality of sets of membership information.” ([0029], [0035] [0093], i.e. when the smart card is inserted into the game machine, previous game play information is loaded initially so that any points, money, pay tables, etc. acquired from previous games are incorporated into the new game. Furthermore, *Merriam-Webster’s* dictionary defines “priority” as something given or meriting attention before competing alternatives, thus a user’s acquired points/pay tables are prioritized over other membership information).

Regarding **claim 9**, Rowe discloses that “wherein the inquiry includes content information regarding the content to be reproduced (i.e. the game machine requests gaming applications), and said operation mode instruction unit is operable to, when the inquiry is received, decide the operation mode including the set of membership information to be prioritized out of the plurality of sets of membership information, on the basis of the content information included in the inquiry.” ([0011], [0029], [0035], [0091], [0093]).

Regarding **claim 10**, Rowe discloses “said terminal body further includes: an operation mode inquiry unit operable to inquire of said secure device about which operation mode is to be selected ([0064], [0093]-[0094], i.e. the game machine transmits application requests to the smart card) and said secure device includes: an operation mode instruction unit operable (processor 110) to, when the inquiry is received, decide the operation mode and the membership status on the basis of the membership information, the membership point value, and the rule, and to instruct said terminal body as to the decided operation mode and the decided membership status, wherein said operation mode setting unit (I/O interface 120) is operable to set the operation mode on the basis of the instruction as to the operation mode and the membership status decided by the operation mode instruction unit.” ([0014], [0025]-[0026], [0029]-[0031], [0093]-[0094], Figs. 1, 3, 6, i.e. the processor receives game application selections from the game machine so as to instruct which game to run. Based on the user's point total, the smart card instructs the game machine to execute a bonus game. In addition, the I/O interface communicates setting instruction to the game machine).

Rowe fails to disclose that “said secure device includes: a membership point storage unit operable to store a membership point value given to the user; a rule storage unit operable to store a rule as to a membership status granted to the user according to the membership point value”

Bryant discloses that “said secure device includes: a membership point storage unit operable to store a membership point value given to the user; a rule storage unit

operable to store a rule as to a membership status granted to the user according to the membership point value" (Col. 1 lines 32- 42, Col. 6 lines 35-49, i.e. the smartcard stores points accumulated by the member. The points make the player eligible for certain bonus features). Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of providing a membership point storage unit and rule storage unit as taught by Bryant, to improve the smart card gaming machine system of Rowe for the predictable result of allowing the user to use and transfer membership points to other gaming machines.

Regarding **claim 11**, Rowe discloses that "said secure device is an IC card (smart card 100), said terminal body further includes an IC card slot into which said IC card is to be inserted (card reader 224)" (Fig. 2)

Rowe fails to disclose that "said operation mode setting unit is operable to set the operation mode on the basis of an insertion state of said IC card with respect to said IC card slot..."

Bryant discloses that "said operation mode setting unit is operable to set the operation mode on the basis of an insertion state of said IC card with respect to said IC card slot." (Col. 4 lines 34-39, Col. 5 lines 31-50). Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of providing an operation mode setting unit is operable to set the operation mode on the basis of an insertion state of said IC card as taught by Bryant, to improve the smart card gaming machine system of Rowe for the predictable result of allowing the users to transfer and use their membership status on various machines.

Regarding **claim 12**, Rowe discloses “a content reproduction method used by a content reproduction terminal (gaming machine 200) comprising a terminal body (gaming machine case) and a secure device (smart card 100) that is removable from the terminal body, the secure device having a first storage unit that previously stores a first application program for reproducing content...” (*Abstract*, [0014], [0054], Figs. 1-2, i.e. gaming applications are stored on the smart card which are downloaded to the gaming machine)

“the terminal body having a second storage unit that previously stores a second application program for reproducing the content.” ([0014], [0054], [0093]-[0094], Fig. 3, i.e. game component information can be stored in RAM, hard drive 320, non-volatile memory 335).

Rowe fails to disclose that “the second application program being different from the first application program, a membership information hold step of holding, in the secure device, membership information which is distributed to a membership user and indicates a group to which the user belongs; an operation mode setting step of setting, in the terminal body, an operation mode on the basis of the membership information held in said membership information hold step; and a reproduction step of reproducing, in the terminal body, the content differently depending on a setting result of said operation mode setting step, wherein said reproduction step includes: a selection step of selecting one of the first application program and the second application program which are stored in the first storage unit and the second storage unit, respectively, in accordance with the setting result; and an execution step of executing the application

program selected in said selection step to reproduce the content (Col. 4 lines 9-21), and wherein the first application program causes said execution step to execute a members-only decorative display."

Bryant discloses that "the second application program being different from the first application program and a secure device (smartcard) to be placed in the terminal body, said method comprising: a membership information hold step of holding, in the secure device, membership information which is distributed to a membership user and indicates a group to which the user belongs (Col. 2 lines 1-18, Col. 4 lines 22-39, i.e. the membership information is stored within the smartcard, Fig. 3); an operation mode setting step of setting, in the terminal body, an operation mode on the basis of the membership information held in said membership information hold step (Col. 2 lines 1-29, i.e. when the membership card is inserted into the card reader the console will determiner if the user is a member. If the user is a member then the console will operate in the second members-only mode); and a reproduction step of reproducing, in the terminal body, the content differently depending on a setting result of said operation mode setting step" (Col. 4 lines 9-21), wherein

"said reproduction step includes: a selection step of selecting one of the first application program and the second application program which are stored in the first storage unit and the second storage unit, respectively, in accordance with the setting result (Col. 2 lines 1-29, Col. 5 lines 31-50, i.e. a test is performed to determine if the member card has been inserted. If the result is yes, then the game will feature a second mode available only to members); and an execution step of executing the application

program selected in said selection step to reproduce the content (Col. 4 lines 9-21), and wherein the first application program causes said execution step to execute a members-only decorative display." (Col. 1 line 46-Col. 2 line 29, Col. 5 lines 4-13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the smart card gaming machine system of Rowe by specifically providing two application programs in which the first application program is provided for members-only as taught by Bryant, for the purpose of providing users with an incentive to become members to view enhanced game modes.

Regarding **claim 13**, claim 13 is interpreted and thus rejected for the reasons set forth above in the rejection of claim 12.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Q. Huerta whose telephone number is (571) 270-3582. The examiner can normally be reached on M-F(Alternate Fridays Off) 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alexander Q Huerta  
Examiner  
Art Unit 2427

February 16, 2010

/Scott Beliveau/  
Supervisory Patent Examiner, Art Unit 2427